

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

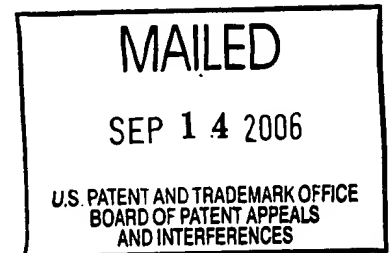
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL T. BRESCIA

Appeal No. 2006-2418
Application No. 09/973,412

ON BRIEF



Before JERRY SMITH, MACDONALD and HOMERE, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 39-54, which constitute all the claims pending in this application.

The disclosed invention pertains to providing content to a mobile terminal based on the terminal's current location. Specifically, multiple unique internet protocol (IP) addresses are associated with different geographic locations. After determining the terminal's current location, a unique IP address is identified that corresponds to the terminal's location, and the identified IP address is delivered to the mobile terminal.

Representative claim 39 is reproduced as follows:

39. A method for providing content to a mobile terminal user based on a location of a mobile terminal, comprising:

establishing a plurality of unique internet protocol addresses from each of which unique content may be accessed, wherein said unique content is location specific;

associating each of the plurality of unique internet protocol addresses with different geographic locations based on the location specific unique content;

determining a current location of the mobile terminal;

determining if content is available for the current location of the mobile terminal;

identifying which of the plurality of unique internet protocol addresses corresponds to the current location of the mobile terminal;

delivering the identified address to the mobile terminal such that the mobile terminal user may selectively access the content using the identified address.

The examiner relies on the following references:

Guedalia	6,480,711	Nov. 12, 2002 (Filed Sept. 15, 1998)
Heddaya et al. (Heddaya)	6,622,157	Sept. 16, 2003 (Filed Sep. 24, 1999)
Owensby	6,647,257	Nov. 11, 2003 (Filed Dec. 10, 1998)

The following rejections are on appeal before us:¹

1. Claims 39-43, 46-51, and 54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Owensby in view of Heddaya.

¹ Appellant's statement of the grounds of rejection to be reviewed on appeal includes a rejection of claims 39 and 47 under 35 U.S.C. § 112, second paragraph [brief, page 2]. The examiner, however, did not include the rejection in the answer notwithstanding indicating that appellant's statement of the grounds of rejection in the brief was correct [see answer, page 4]. See also reply brief, page 2 (acknowledging the examiner's failure to address the rejection). Since the examiner did not address this rejection in the answer, we presume that the examiner withdrew this rejection.

2. Claims 44, 45, 52, and 53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Owensby in view of Heddaya and further in view of Guedalia.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467

(1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). See also In re Thrift, 298 F. 3d 1357, 1363,

63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the briefs have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

Regarding independent claims 39 and 47, the examiner's rejection essentially finds that Owensby teaches every claimed feature except for (1) associating each of the plurality of unique IP addresses with geographic locations, and (2) providing unique content to a mobile user when the IP address is based on the location-specific unique content [answer, pages 5 and 6]. The examiner cites Heddaya as disclosing such features and finds that it would have been obvious to one of ordinary skill in the art at the time of the invention to implement the offloaded customization concepts of Heddaya into Owensby's method and

apparatus to customize content and render such content unique in accordance with the intermediate node's location [answer, pages 6 and 7]. According to the examiner, such a combination would reduce response time and decrease network traffic by distributing servicing of requests across multiple intermediate servers [answer, page 8].

Appellant argues that the examiner did not establish a proper motivation to combine the references [brief, page 7]. Appellant notes that the examiner's motivation to combine Owensby and Heddaya does not create the advantage stated by the examiner [brief, page 8]. Although appellant acknowledges that the intermediate server in Heddaya customizes the document that is sent to the client, appellant notes that such customization is not made unique according to the location of the intermediate server [id.].

The examiner responds that since (1) Owensby discloses providing localized information to a wireless terminal via the internet, and (2) Heddaya provides localized information using URLs and TCP/IP, the skilled artisan would be motivated to seek more detailed disclosures regarding presenting internet content to a wireless terminal [answer, page 13].

Appellant also argues that the examiner's combination of references renders Heddaya unsuitable for its intended purpose [brief, page 9]. According to appellant, customizing content in accordance with the location of the intermediate node would

vitiating Heddaya's purpose of providing proxy intermediate nodes that spoof the client into believing that the proxy is the desired server [id.]. Appellant notes that once the content diverges between the various nodes, the mobile agent of Heddaya would no longer know how to intercept messages and reroute requests to the closest server [id.; reply brief, pages 4 and 5]. The examiner responds that Heddaya is not limited to such spoofing techniques and is well suited for its intended purpose of associating IP addresses with unique content and providing location-specific content [answer, page 14].

Appellant argues that the references do not disclose establishing a plurality of unique IP addresses from each of which unique content may be accessed as claimed [brief, page 10]. Appellant emphasizes that the mere mention of the internet or TCP/IP in various passages within the references hardly teaches or suggests the claimed limitation [brief, pages 10 and 12]. The examiner responds that the claimed limitation is met by the prior art since (1) Heddaya uses URLs to link to internet content, and (2) URLs inherently provide a unique protocol address from each of which unique content may be accessed [answer, pages 14 and 15].

In addition, appellant argues that the references do not disclose associating each of the plurality of unique IP addresses with different geographic locations as claimed [brief, page 12]. Appellant notes that merely because Owensby states that

information may vary based on the subscriber's location does not mean that IP addresses are associated with different geographic locations. According to appellant, Owensby does not indicate that the information is associated with any IP address; rather, the information is inserted into the call [brief, page 13; reply brief, page 7]. Appellant emphasizes that Owensby is silent regarding the storage mechanism containing the information or how the information is accessed that is inserted into the call [id.]. The examiner responds that Owensby provides links to localized information dependent upon the location of the mobile terminal, and Heddaya provides URLs to link to localized information [answer, page 15].

We will not sustain the examiner's rejection of independent claims 39 and 47. In particular, we find no reasonable teaching or suggestion on this record regarding the last recited limitation of the independent claims -- namely delivering the identified IP address to the mobile terminal to enable the user to selectively access location-specific unique content as claimed.

Turning to the prior art, Owensby inserts messages (e.g., advertisements) into a wireless mobile communication based on the terminal's location [Owensby, col. 11, lines 20-25]. Although Owensby notes that the wireless mobile terminal could be a computer and communicate wirelessly via the Internet [Owensby, col. 11, lines 56-65], the reference does not indicate that the

location-specific messages sent to such terminals are IP addresses (i.e., links) that enable the user to selectively access the unique location-specific content.

In addition, Heddaya does not remedy the deficiencies of Owensby noted above. In Heddaya, an intermediate node intercepts service requests from a client node to a primary server node. The intermediate node then instructs a selected secondary server node to provide the service [Heddaya, abstract]. As a result, the client node is spoofed into believing the response came from the primary server node [Heddaya, col. 11, lines 12-24]. Heddaya also discusses various other approaches in the background section including mirroring servers and offloading servicing work to an intermediate node that modifies a received document and sends the modified document to the client [Heddaya, col. 2, lines 47-61; col. 3, lines 24-31].

Although Heddaya's service requests include access to information encoded in hypertext transfer protocol (HTTP) documents and document request messages are sent in the form of URLs using the TCP/IP protocol [Heddaya, col. 6, lines 44-49], the reference hardly teaches or suggests actually delivering identified URLs that correspond to the location to a user's mobile terminal for selective access to the unique location-specific content as claimed.

At best, the collective teachings of Owensby and Heddaya suggest generally automatically sending location-related

information to a user's wireless terminal based on the terminal's location. But the prior art hardly suggests that such information be in the form of IP addresses, let alone IP addresses from each of which unique location-specific content may be accessed as claimed. On this record, the only reasonable suggestion to deliver such location-specific IP addresses in the manner claimed stems from appellant's own disclosure which ultimately results in improper hindsight reconstruction of the invention.

Although we cannot say that no prior art exists suggesting that delivering such identified IP addresses to a mobile terminal would have been obvious to the skilled artisan, we can say that no such prior art exists on this record. Because the examiner has not established a prima facie case of obviousness of independent claims 39 and 47, the rejection of those claims is therefore reversed. Since we do not sustain the examiner's rejection of the independent claims, we likewise do not sustain the examiner's rejection of dependent claims 40-43, 46, 48-51, and 54.

With regard to the rejection of dependent claims 44, 45, 52, and 53, the examiner adds Guedalia to the Owensby/Heddaya combination [answer, pages 9-11]. However, since Guedalia does not cure the deficiencies noted above with respect to independent claims 39 and 47, the obviousness rejection of claims 44, 45, 52, and 53 over Owensby, Heddaya, and Guedalia is also not sustained.

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